

composition having a specific viscosity. The Office Action states that Claim 30 additionally contains the skin care composition comprising a skin care active ingredient.

#### APPLICANTS' ELECTION WITH TRAVERSE

In order to make an election in compliance with the M.P.E.P., Applicants elect the species in Claim 1. Applicants respectfully traverse this election requirement.

First, applicants respectfully submit that the election is improper because Claim 1 and Claim 30 are clearly unpatentable over each other and belong to a single general invention concept. M.P.E.P. §808 provides **the election of species should not be required if the species claimed are considered clearly unpatentable over each other** (Emphasis in the original). Claim 1 recites an absorbent article comprising a body contacting surface and an absorbent core wherein at least a portion of the body contacting surface comprises an effective amount of a skin care composition which is solid or semisolid at 40°C and which is transferable from the body containing surface to the wearer's skin by contact, normal wearer motion and body heat at a level effective in providing a skin benefit to the wearer's skin and the skin care composition has a viscosity of more than about  $10^5$  Poise under shear stress of less than about  $3 \times 10^4$  dynes/cm<sup>2</sup>, and viscosity of less than about  $10^2$  Poise under shear stress of less than about  $3 \times 10^6$  dynes/cm<sup>2</sup> at 40°C. Claim 30 recites an absorbent article comprising a body contacting surface and an absorbent core wherein at least a portion of the body contacting surface comprises an effective amount of a skin care composition which is solid or semisolid at 40°C and which is transferable from the body containing surface to the wearer's skin by contact, normal wearer motion and body heat at a level effective in providing a skin benefit to the wearer's skin, the skin care composition comprises a skin care active ingredient, and the skin care composition has a viscosity of more than about  $10^5$  Poise under shear stress of less than about  $3 \times 10^4$  dynes/cm<sup>2</sup>, and viscosity of less than about  $10^2$  Poise under shear stress of less than about  $3 \times 10^6$  dynes/cm<sup>2</sup> at 40°C. Claim 30 merely adds the limitation of the skin care composition comprises a skin care active ingredient. Clearly, if the species contained in Claim 30 were allowed one could not practice the species contained in Claim 30 without infringing Claim 1. Thus, the restriction of the species in Claim 1 and Claim 30 is not proper because Claim 1 and Claim 30 are clearly unpatentable over each other. Moreover, Claim 1 and Claim 30 belong to a single inventive concept.

Second, the Applicants submit that the Examiner has not satisfied various requirements in the M.P.E.P. in rendering the election of species requirement. M.P.E.P. §808 provides that:

Every requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween as set forth in the following sections. (Emphasis in original)

Aside from the very brief statement regarding the election of species in reference to the figures, the remainder of the Examiner's action relates to procedural issues. Applicants submit that in this regard, the Examiner has failed to provide a requisite basis for the election of species requirement per Part (1) of M.P.E.P. §808. Instead, the Examiner's comments regarding the election are merely conclusory. Furthermore, contrary to Part (2) of M.P.E.P. §808, the Examiner has provided no reasons, as described in other sections of the M.P.E.P., for insisting upon election.

The Examiner's failure to provide the proper basis for the election of species requirement, further requirements of the M.P.E.P., makes it impossible for Applicant to provide a meaningful traversal in this response. A more detailed requirement is hereby requested.

Substantively, Applicants respectfully submit that each of the absorbent articles depicted in Claims 1 and Claim 30 are related, in so far as they describe an absorbent article comprising a body contacting surface and an absorbent core wherein at least a portion of the body contacting surface comprises an effective amount of a skin care composition which is solid or semisolid at 40°C and which is transferable from the body containing surface to the wearer's skin by contact, normal wearer motion and body heat at a level effective in providing a skin benefit to the wearer's skin and the skin care composition has a viscosity of more than about  $10^5$  Poise under shear stress of less than about  $3 \times 10^4$  dynes/cm<sup>2</sup>, and viscosity of less than about  $10^2$  Poise under shear stress of less than about  $3 \times 10^6$  dynes/cm<sup>2</sup> at 40°C. Claim 30 merely adds the limitation of the skin care composition comprises a skin care active ingredient.

M.P.E.P §808.02 states that the Examiner, in order to establish reasons for insisting upon restriction, must share by appropriate explanation one of the following criteria: (1) separate classification thereof; (2) a separate status in the art when they are classifiable together; or (3) a different field of search. The Examiner has pointed to none of these reasons for insisting upon restriction. M.P.E.P. §808.02, last paragraph, states that where, however, the classification is the same and the field of search is the same and there is no clear indication of separate feature classification in the field of search, no reasons exist for dividing among related inventions. This is presently the case in the present invention. The Examiner has provided no clear indication that

the various claims would be put into separate future classifications or require a different field of search. In fact, it is believed by the Applicants that the classification of the various alternative embodiments in the claims would be the same and the field of search is the same. For this reason alone the restriction requirement is improper.

Finally, M.P.E.P. §806.01 states that in passing upon questions of restriction, it is the "claimed subject matter" that is considered and such claimed subject matter "must be compared in order to determine the question of distinctiveness or independence." The Examiner has failed to make any consideration or comparison of the claimed subject matter in order to determine the question of distinctiveness or independence. The Examiner has merely provided conclusory statements that the application contains claims to patentably distinct species. There is no detailed analysis or comparison of any of the claims. This type of conclusory restriction requirement is improper under the rules.

For all of the above reasons, Applicants hereby traverse the restriction requirement since the restriction in this instance is improper and the Examiner failed to provide the proper analysis and detailed explanation in the Restriction Requirement mandated by the rules. Further, the conclusory statements of the Examiner make it impossible for Applicant to provide a meaningful traversal. For all of the above reasons, the Restriction Requirement is improper and should be withdrawn.

#### CONCLUSION

Applicants have elected, with traverse, to prosecute the species in Claim 1. The claims that read on the elected species are Claims 1-29. Because the Examiner has not satisfied the burden of demonstrating that election between the species is proper, Applicants request reconsideration of the election of species requirement.

Respectfully submitted,

By Bridget D. Ammons  
Bridget D. Ammons  
Attorney for Applicant(s)  
Registration No. 52,555  
(513) 634-1873

January 12, 2004  
Cincinnati, Ohio